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EXAMINER

COMBS, JANELL A

ART UNIT

PAPER NUMBER

1742

DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/508,490

Applicant(s)

BODE ET AL.

Examiner

Janelle Combs-Morillo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 4 and 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Appeal Brief

1. In view of the appeal brief filed on March 24, 2003, PROSECUTION IS HEREBY REOPENED. This was necessary for the examiner to fully respond to applicant's arguments, and to clarify the record in the "Claim Interpretation" section.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

If reinstatement of the appeal is requested, the request must be accompanied by a supplemental appeal brief; however, no new amendments, affidavits (37 CFR 1.130, 1.131, or 1.132), or other evidence is permitted. The supplemental appeal brief must comply with the requirements of 37 CFR 1.192(c), but in doing so may incorporate by reference such parts of the previously-filed brief as may still be applicable. The arguments presented in the supplemental appeal brief need only be those relevant to the new ground(s) of rejection raised in the Office action that reopened prosecution, but the appellant should also identify all previously-raised issues and/or arguments which are still considered to be relevant. If the examiner does not consider that the supplemental appeal brief complies with the foregoing requirements, appellant

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should be given a 1-month time period within which to file an amended supplemental brief under 37 CFR 1.192(d). See MPEP § 1206, 1208.02.

Claim Interpretation

2. In the previous action (paper no. 13), the instant claims were rejected under 112 second paragraph as being indefinite. In the response filed on March 24, 2003, applicant clarified the definition of “ageing sensitive” steel, and provided no comment to the examiner’s point that one of ordinary skill in the art would expect aluminum containing steels (aluminum killed steels) to be ageing resistant. Therefore, the examiner interprets “ageing sensitive steel” to broadly encompass both killed and non-killed steels, to the extent that said steel “tends to age as the result of the diffusion of the dissolved substances included in its structure” (arguments page 5 lines 15-17).

3. The term “high bake-hardening potential” is defined by the applicant as-

“high bake-hardening potential as a rule use is made of steels which contain dissolved nitrogen as well as dissolved carbon. Examples of these are unkilld steels” (page 1 lines 6-8).

The examiner notes that this is the only place where a description/definition of said term was found in the instant specification. Therefore, the examiner interprets unkilld steels to fall within applicant’s definition of “high bake-hardening potential”.

4. The term “stove- finished” was defined/described by applicant in paper no. 5 to be synonymous with “stove enamel” and “stove drying” (response filed on July 16, 2001, page 4 lines 11-13, see also Exhibit B of said response).

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5. In the phrase “for the production of a buckling resistant stove-finished structural component *from* a cold strip which comprises ageing-sensitive steel” (claim 1 lines 1-2, claim 3 lines 1-2, emphasis added), the final product is interpreted by the examiner to be “a buckling resistant stove-finished structural component” while the starting product is interpreted by the examiner to be “a cold strip which comprises ageing-sensitive steel”. This is because the final product is produced “*from*” the starting product.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakaoka et al (US 4,323,403) in view of “ASM Handbook: Vol.1 Properties and Selection: Irons, Steels, and High-Performance Alloys” pp 141-146, 204-208, 212-215, 573-575, 578-580 (hereinafter “ASM Vol. 1”) or “The Making, Shaping and Treating of Steel” pp 410-413, 1118-1119, 1135-1138, 1283-1287, 1398-1404.

Nakaoka teaches a process for the production of steel sheets with good press formability (column 1 lines 15-19) comprising the steps of: providing a low carbon rimmed steel (column 3 line 29), subjecting said steel to temper rolling (column 5 lines 45-46) in order to achieve a yield point elongation=0 (column 5 line 49, column 6 lines 35-36), aging so that the yield point

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elongation <1.2% (column 6 lines 46-47), wherein said steel sheet is usable for drawing purposes such as press forming (column 1 lines 15, 35).

Low carbon rimmed steels, as taught by Nakaoka, are known in the art to be unkilld and ageing sensitive. This is supported by "ASM Vol. 1" descriptions of "Types of Steel Based on Deoxidation Practice" page 142, which classifies steels as either killed, semikilled, rimmed, or capped. Rimmed steels are not killed steels, and often referred to as "unkilled" (see "ASM Vol. 1" page 143 1st column, which teaches rimmed steels do not contain deoxidizing agents, while page 142 1st column teaches that killed steels are fully deoxidized by additions of Si and/or Al). The ageing behavior of killed vs. rimmed steels is taught by "ASM Vol. 1" at pages 204-205. More specifically, on page 205 3rd column,

"Killed carbon steels have very little susceptibility to strain aging because their nitrogen content is essentially chemically combined with aluminum. Rimmed and capped steels, however, tend to strain age because they contain greater amounts of nitrogen in solid solution (typically 6 to 30 ppm)"

The low carbon rimmed steels taught by Nakaoka are clearly unkilld and ageing sensitive.

The examiner points out that press forming qualifies as "cold working to give a structural component", as presently claimed. Nakaoka does not mention a) the strip is stored below room temperature, b) the strip is "stove-finished", or c) that said ageing sensitive steel exhibits the property of "high bake-hardening potential".

Concerning item a), the examiner points out that aging is well known to be a diffusion controlled process (dependent on temperature). This is further supported by Nakaoka who teaches that natural aging of 2 months at room temperature (25°C) is equivalent to aging 8 days at 38°C (column 3 lines 42-45). This is further supported by "The Making, Shaping and Treating of Steel" which teaches that aging 1 year at 0°C is equivalent to 6 months at room temperature

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(page 1286 Table 42, etc.), wherein the diffusion of C into austenitic Fe is represented by the following equation-

$$D = D_o e^{-\frac{R}{RT}} \text{ (page 410, 411).}$$

It would have been obvious to one of ordinary skill in the art, and within the disclosure of Nakaoka (alternatively in view of “The Making, Shaping and Treating of Steel”), to store said aging sensitive steel at temperatures lower than room temperature in order to delay the aging response.

Concerning item b), the term “stove- finished” was defined/described by applicant in paper no. 5 to be synonymous with “stove enamel” and “stove drying” (see above “Claim Interpretation” section). It is known in the art of formable low carbon steel sheets to provide a coating (including enamel coatings) in order to improve corrosion resistance (ASM Vol 1, pp 212 2nd column under heading “Corrosion Resistance”, p 579 3rd column last 2 lines- p 580 lines 1-4)(or “The Making, Shaping and Treating of Steel” p 1136 2nd full paragraph under “Organic Coatings” section) of low carbon steel sheets. Therefore, it would have been obvious to one of ordinary skill in the art to provide an enamel coating (a stove finish) to the ageing sensitive steel sheet processed by the temper rolling, ageing below room temperature, and cold forming process taught by Nakaoka, because the ASM Handbook or “The Making, Shaping and Treating of Steel” teaches that said coating improves corrosion resistance.

Concerning item c), as stated above in the “Claim Interpretation” section, unkilld steels fall within applicant’s definition of “high bake-hardening potential”. Furthermore, the steel taught by Nakaoka, a low carbon rimmed steel (which the examiner has already set forth as unkilled and sensitive to ageing), falls within applicant’s definition of “high bake-hardening

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potential". One of ordinary skill in the art would expect the unkilld rimmed steel taught by Nakaoka to exhibit bake hardenability within the presently claimed "high bake-hardening potential", by virtue of it's being an unkilld skill (because it meets applicant's definition of said term).

Concerning dependent claim 2, the instant equation describes the diffusion of N into ferritic steel, and more specifically, equivalent ageing times and temperatures to ageing at 20°C for a time of 48 hours. This general relationship is known in the art. "The Making, Shaping and Treating of Steel" teaches the diffusion of C and N into ferritic Fe is represented by the following equation-

$$D = D_0 e^{-\frac{E}{RT}} \text{ (page 410, 411)}$$

where R is the gas constant, D_0 is the diffusivity, E is the activation energy (given in Table 13 of "The Making, Shaping and Treating of Steel" p 411), upon which the presently claimed relationship is based. It would have been obvious to optimize the aging time and temperature conditions according to the above relationship, because it is known that ageing at different times and temperatures achieves a recognized result, and therefore the optimum or workable ranges of said variables are characterized as routine experimentation.

Changes in temperature, concentrations, or other process conditions of an old process does not impart patentability unless the recited ranges are critical, i.e. they produce a new and unexpected result. However, said parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.

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In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). See also *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakaoka et al (US 4,323,403) in view of “ASM Handbook: Vol.1 Properties and Selection: Irons, Steels, and High-Performance Alloys” pp 141-146, 204-208, 212-215, 573-575, 578-580 or “The Making, Shaping and Treating of Steel” pp 410-413, 1118-1119, 1135-1138, 1283-1287, 1398-1404.

Nakaoka teaches a process for the production of steel sheets with good press formability (column 1 lines 15-19) comprising the steps of: 1) providing low carbon rimmed steels (column 3 line 29) initially at room temperature (Fig. 1, column 2 lines 45-49), 2) subjecting said steel to temper rolling (column 5 lines 45-46) in order to achieve a yield point elongation=0 (column 5 line 49, column 6 lines 35-36), 3) drawing such as press forming (column 1 lines 15, 35).

More specifically concerning step 1), because Nakaoka teaches that said steel strip is initially provided at room temperature, the condition of “storing the cold strip undressed for a storage period at room temperature” (claim 3 line 4) is held to be met.

Concerning the type of steel strip that is provided initially at room temperature, low carbon rimmed steels, as taught by Nakaoka, are known in the art to be unkilld and ageing sensitive. The ageing behavior of killed vs. rimmed steels is taught by “ASM Vol. 1” at pages 204-205. More specifically, on page 205 3rd column,

“Killed carbon steels have very little susceptibility to strain aging because their nitrogen content is essentially chemically combined with aluminum. Rimmed and capped steels, however, tend to strain age because they contain greater amounts of nitrogen in solid solution (typically 6 to 30 ppm)”

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The low carbon rimmed steels taught by Nakaoka are clearly unkilld and ageing sensitive. Therefore, it is held to be within the scope of Nakaoka to provide a strip of rimmed steel (as set forth above to be ageing sensitive) at room temperature.

More specifically concerning step 3), press forming qualifies as “cold working to give a structural component”, as presently claimed. Nakaoka does not mention a) the strip is “stove-finished” after step 3), or b) the killed or rimmed steel has a “high bake-hardening potential”.

Concerning item a), the term “stove- finished” was defined/described by applicant in paper no. 5 to be synonymous with “stove enamel” and “stove drying”. It is known in the art of formable low carbon steel sheets to provide a coating (including enamel coatings) in order to improve corrosion resistance (ASM Vol 1, pp 212 2nd column under heading “Corrosion Resistance”, p 579 3rd column last 2 lines- p 580 lines 1-4)(or “The Making, Shaping and Treating of Steel” p 1136 2nd full paragraph under “Organic Coatings” section) of low carbon steel sheets. Therefore, it would have been obvious to one of ordinary skill in the art to provide an enamel coating (a stove finish) to the ageing sensitive steel sheet processed by the temper rolling, ageing below room temperature, and cold forming process taught by Nakaoka, because the ASM Handbook or “The Making, Shaping and Treating of Steel” teaches that said coating improves corrosion resistance.

Concerning item b), as stated above in the “Claim Interpretation” section, unkilld steels fall within applicant’s definition of “high bake-hardening potential”. Furthermore, the steel taught by Nakaoka, a low carbon rimmed steel (which the examiner has already set forth as unkilled and sensitive to ageing), falls within applicant’s definition of “high bake-hardening potential”. One of ordinary skill in the art would expect the unkilld rimmed steel taught by

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Nakaoka to exhibit bake hardenability within the presently claimed "high bake-hardening potential", by virtue of it's being an unkill skill (because it meets applicant's definition of said term).

Response to Arguments

9. Applicant's argument that claims 1-5 are not indefinite has been found persuasive. As stated in the above "Claim Interpretation" section, the examiner interprets "ageing sensitive steel" to broadly encompass both killed and non-killed steels, to the extent that said steel "tends to age as the result of the diffusion of the dissolved substances included in its structure" (applicant's arguments page 5 lines 15-17).

Applicant's argument that the present invention is allowable over the prior art of record because "the steel sheets produced according to the teaching of Nakaoka are not ageing sensitive, as they are characterized by having a high ageing resistance (arguments page 6 lines 14-15) has not been found persuasive. As stated in the above "Claim Interpretation" section, the initial starting material of the instant process is an ageing sensitive steel. As set forth above, the initial starting material of Nakaoka is clearly also an ageing sensitive steel.

Applicant's argument that the present invention is allowable over the prior art of record because Nakaoka focuses on properties such as work-hardenability, while not producing a steel with high-hardening potential (arguments page 7 line 3), or that "the method of Nakaoka is restricted to low carbon, rimmed steel, low carbon Al-killed steel and low carbon Si- killed steel. However, no further specific restrictions exist on reduced C, Mn, S, P and O₂ contents or varied correlation between them" (argument page 7 lines 12-13) has not been found persuasive. First of all, the presently claimed "ageing-sensitive steel with a high bake-hardening potential" (claim 1

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lines 2-3, claim 3 lines 2-3) is the starting material for the instant method (see above “Claim Interpretation” section for explanation). Nakaoka teaches an ageing-sensitive (rimmed or unkilld) steel starting material, wherein said unkilld steel is expected to exhibit “a high bake-hardening potential”, given the definition/description of the term “high bake-hardening potential” in the instant specification-

“high bake-hardening potential as a rule use is made of steels which contain dissolved nitrogen as well as dissolved carbon. Examples of these are unkilld steels” (page 1 lines 6-8).

See also “Claim Interpretation” section. The fact that Nakaoka doesn’t restrict the composition (besides preferring a rimmed steel) does not mean that the steel taught by Nakaoka does not exhibit “a high bake-hardening potential” (within the instant definition/description of said term).

Applicant’s argument that the present invention is allowable over the prior art of record because “this effect [bake hardening] cannot be achieved with the steels processed according to the method disclosed in Nakaoka, because these steels are already in a harden state after the cold forming step” (arguments page 9 lines 10-12, see also arguments page 11), or that “hardness of the product is not achieved during cold forming of the steel sheet, as it is in the case of a work-hardening steel produced according to Nakaoka, but after the cold forming, in an additional heating step which is performed to stove enameling” (arguments page 9 lines 1-4) has not been found persuasive. As stated above, the instant claims are drawn to a method performed on an ageing-sensitive steel with a high bake hardening potential as the starting material. The prior art clearly teaches a process substantially as presently claimed, performed on a starting material comprising an ageing-sensitive steel with “a high bake hardening potential”, by virtue of it’s being an unkilld steel, because it meets applicant’s definition of said term. When the hardness of

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the product of Nakaoka is achieved is not relevant, because the instant claim language is open, this is not explicitly part of the instant claim, and/or applicant has not set forth unexpected results with respect to this issue. Concerning the fact that the instant process has open claim language, the examiner points out that said claim does not limit the processing steps to those claimed (see MPEP 2111.03, Transitional Phrases). Concerning the fact that said issue is not explicitly part of the instant claim, it is noted that the features upon which applicant relies (i.e., when the steel obtains a hardness) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Concerning the showing of unexpected results, applicant has not shown specific unexpected results with regard to the prior art process, and as performed on the rimmed unkilld steel taught by the prior art (which is expected to exhibit high bake hardening potential, by virtue of it's being an unkilld skill, because it meets applicant's definition of said term, as stated above).

Applicant's argument that the present invention is allowable over the prior art of record because Nakaoka is designed to modify the annealing in order to overcome the typical wait period of 2-3 months between manufacture and consumption, with the least deterioration of the material (arguments bottom of page 6- top of page 7), or applicant's invention is processed in an age-sensitive state (arguments, page 9) while Nakaoka teaches a final product that is free from the problem of age-sensitivity (arguments, page 9), or that for Nakaoka "the storage and subsequent processing of this steel is uncritical" (arguments page 10 lines 4-5), has not been found persuasive. The degree of age sensitivity of the steel at the time of a particular processing step (such as storage) is not a limitation in the instant claims (See *In re Van Geuns*, 988

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F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993), nor does it overcome the prima facie case of obviousness. Concerning the motivation to perform a process step of storing the alloy of Nakaoka below room temperature for a period of time, the prior art clearly teaches motivation to do this - storing steel at temperatures lower than room temperature delays the aging response (see rejection above). Additionally, because it is known that ageing at different times and temperatures achieves a recognized result, then the optimum or workable ranges of said variables are characterized as routine experimentation (see also above rejections). Therefore, the storage time and temperatures of the steel of Nakaoka is not uncritical.

Applicant's argument that the present invention is allowable over the prior art of record because "enameling the product made from the steel produced according to the process disclosed in Nakaoka will not lead to an increased hardness of the product, because the steels processed according to Nakaoka do not have bake-hardening properties" (arguments page 11 lines 8-11) has not been found persuasive. The examiner points out that the instant claims do not mention the bake-hardening properties of the final product, but are drawn to performing a process on a steel with "a high bake-hardening potential" as the starting material. As set forth above, Nakaoka teaches an ageing-sensitive (rimmed or unkilld) steel *starting material*, wherein said unkilld steel is expected to exhibit "a high bake-hardening potential", given the definition/description of the term "high bake-hardening potential" in the instant specification. With regard to applicant's assertion that "the steels processed according to Nakaoka do not have bake-hardening properties" (arguments page 11 lines 11) in the final product, while applicant is able to achieve such properties in the final product, applicant has not shown specific unexpected results with regard to the prior art process, and as performed on the rimmed unkilld steel taught by the prior art

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(which is expected to exhibit high bake hardening potential, by virtue of it's being an unkilld skill, because it meets applicant's definition of said term).

Allowable Subject Matter

10. Claims 4 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter: the closest prior art, Nakaoka combined with "ASM Vol. 1" or "The Making, Shaping and Treating of Steel", does not teach or suggest how to obtain a final product with a bake hardenability within the presently claimed "at least 70 N/mm²".

Conclusion


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janelle Combs- Morillo whose telephone number is (703) 308-4757. The examiner can normally be reached Monday through Friday from 7:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (703) 308-1146. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

jcm 

June 13, 2003


GEORGE WYSZOMIERSKI
PRIMARY EXAMINER